



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/691,900	10/22/2003	Paul G. Yock	701470.4086	6609

34313 7590 05/27/2005

ORRICK, HERRINGTON & SUTCLIFFE, LLP
IP PROSECUTION DEPARTMENT
4 PARK PLAZA
SUITE 1600
IRVINE, CA 92614-2558

EXAMINER

JAWORSKI, FRANCIS J

ART UNIT	PAPER NUMBER
----------	--------------

3737

DATE MAILED: 05/27/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/691,900

Applicant(s)

YOCK, PAUL G.

Examiner

Jaworski Francis J.

Art Unit

3737

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 March 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 102202 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>102203</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Specification

The disclosure is objected to because of the following informalities: The status of the immediate parent case should be updated by insertion in line 2 after " 2002 " of -- (now U.S. Patent No. 6,572,554) --. .

Appropriate correction is required.

Drawings

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference characters "21" and "23" have both been used to designate the outermost portion of the catheter tube in Fig. 4. That is to say, the lead arrow from 21 should point to the underlying shield layer containing the strands 22 and not to the covering 23. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Art Unit: 3737

Claims 1-8 are present for examination in this case; claims 9-21 have been cancelled in the election response filed on March 7, 2005.

Claim Objections

Claim 6 is objected to because of the following informalities: It is self-dependent whereas it is clear from the context that dependency from claim 5 is intended..

Appropriate correction is required.

Double Patenting

A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

Claims 1-8 are rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-8 of prior U.S. Patent No. 6764450. This is a double patenting rejection.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and

Art Unit: 3737

the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-2, 4-5, 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eggleton et al (US3779234) in view of a newly discovered patent to Seo (US4191193). Eggleton et al teaches an ultrasound imaging catheter having a lumen and an elongated tube member 11 and a distal imaging array 16 disposed in the tubular member and coax (cable) leads 41-44 coupled to the imaging transducers.

While the tubular member is stated to comprise a metal shield or sheath (see col. 3 lines 18-41) it is not specifically stated to be a "braided shield formed of a magnetic material". However it would have been obvious in view of Seo col. 3 lines 13 – 22 to construct such a metal-containing catheter wall out of stainless steel braid 1b inside a covering 1a since this was known to allow the catheter to be flexible so as to be steerable yet non-crushable, which is analogous to the purposes of the shield/sheath 11 of Eggleton et al, see col. 3 lines 49-52 thereof.

The shield would inherently act as an electric shield since thin metal layers such as Seo 17 were known to provide electrical shielding by virtue of their interposition to block external signal pickup..(claim 4)

Inflatable balloon 73 of Eggleton et al is used as a coupler. (claim 9)

Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Eggleton et al in view of Seo as applied to claim 2 above, and further in view of Suzuki et al (US 4610674) since whereas Seo is silent as to how the outer covering 1a is applied, it would have been obvious in view of Suzuki et al to use a heat-shrinkable plastic

Art Unit: 3737

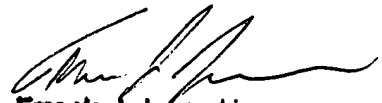
containing member 22 for covering 1a since this allows the covering to contain and fix a coil or strand containing inner member such as 21.

Claims 6-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eggleton et al in view of Seo as applied to claim 5 above, and further in view of Segal (US4733669). Whereas the former are silent as to additional medicament infusion ports, it would have been obvious in view of Segal 16,36,38 to provide through lumens and ports in association with ultrasound catheters since infused fluoroscopic dye may be used to guide the device as inferred therein. Such structures are capable of infusing drugs as well as trace dyes. It would have also been obvious to use an inflatable balloon 22 on the former in order to allow the force of the blood on such a balloon to forwardly propel the catheter as stated in the latter.

Any inquiry concerning this communication should be directed to Jaworski Francis J. at telephone number 571-272-4738.

FJJ:fjj

05252005


Francis J. Jaworski
Primary Examiner